

REMARKS

Claims 1 and 4 through 19 are pending in this Application, of which claims 7 through 12 stand withdrawn from consideration pursuant to the provisions of 37 C.F.R. § 1.142(b). Claim 1 has been amended and new claims 13 through 19 added. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, Figs. 2, 6A, 7B, 10, and 11A through 11C, and the related discussion thereof in the written description of the specification. Applicant submits that the present Amendment does not generate any new matter issue.

Claims 1, 4 and 6 (presumably intending to include claim 5) were rejected under 35 U.S.C. § 103 for obviousness predicated upon Minamino et al. in view of Rosbeck et al.

In the statement of the rejection the Examiner asserted that Minamino et al. disclose every aspect of the claimed invention except for a semiconductor optical device, and then concluded that one having ordinary skill in the art would have been motivated to modify the disclosed device to include a semiconductor photodiode in view of Rosbeck et al. This rejection is traversed.

There are structural differences between the claimed optical module and the module disclosed by Minamino et al. that undermine the obviousness conclusion under 35 U.S.C. § 103. This is because even if the applied references are combined as suggested by the Examiner, and Applicant does **not** agree that the requisite fact-based motivation has been established, the claimed invention would **not** result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Specifically, the Examiner's determination as to the features of the module disclosed by Minamino et al. and attempt to read them on those of the claimed invention do not withstand scrutiny. For example, recess (5f) and side guides (5c) in the device disclosed by Minamino et al. are **different**, repeat **different**, from the first and second leg portions of the claimed invention, because the ends of the respective leg portions thereof of the claimed invention come in contact with the bottom surface of the base. **Not so** in the device disclosed by Minamino et al. where there are **no** leg portions that come in contact with the bottom surface of the base. Repeat, Minamino et al. neither disclose nor suggest any leg portions that come in contact with the bottom surface of the base. The secondary reference to Rosbeck et al. does not cure this fatal defect in the disclosure of Minamino et al.

Based upon the foregoing it should be apparent that even **if** the applied references are combined as suggested by the Examiner, and again Applicant does not agree that the requisite fact-based motivation has been established, the claimed invention would **not** result. *Uniroyal, Inc. v. Rudkin-Wiley Corp., supra*. Applicant, therefore, submits that the imposed rejection of claims 1, 4 and 6 (and presumably 5) under 35 U.S.C. § 103 for obviousness predicated upon Minamino et al. in view of Rosbeck et al. is not factually viable and, hence, solicit withdrawal thereof.

New claims 13 through 19.

New claims 13 through 19 are clearly free of the applied prior art for reasons which should be apparent from those advanced in traversing the rejection of claims 1 and 4 through 6 under 35 U.S.C. § 103. Further, Minamino et al. neither disclose nor suggest an optical

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subassembly that has a **cylindrical** outer shape as in independent claim 13. Accordingly, claims 13 through 19 are free of the applied prior art.

Based upon the foregoing it should be apparent that the imposed rejection has been overcome and that all active claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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